

NIFA PATENTS, INVENTIONS, AND COPYRIGHTS REQUIREMENTS

The central point of contact within the U.S. Department of Agriculture for questions and issues pertaining to patents and inventions (this does **not** include questions and issues regarding Interagency Edison) is:

National Institute of Food and Agriculture, USDA
Planning, Accountability and Reporting Staff
STOP 2213
1400 Independence Avenue, S.W.
Washington, D.C. 20250-2213
Telephone: (202) 720-5623
Facsimile: (202) 720-7714

- a. Invention Disclosure and Related Information Requirements.** [37 CFR Part 401.14](#) requires the disclosure of each subject invention to the Federal Agency within two months after the inventor discloses it in writing to contractor personnel responsible for patent matters. Invention disclosure statements pursuant to [37 CFR Part 401.14\(c\)](#) shall be made by creating an invention record using Interagency Edison. If possible, all supporting documentation shall also be submitted electronically using Interagency Edison. However, if electronic submission of supporting documentation is not feasible, paper copies can be submitted via facsimile or U.S. Mail.

Invention Disclosure

Electronic Submission Via Interagency Edison Web Interface: Interagency Edison (iEdison) can be accessed at <https://s-edison.info.nih.gov/iEdison/>. An overview of the invention iEdison reporting process, an iEdison tutorial, and extensive help text can be found as links on the iEdison home page. Requests for detailed instructions or other questions regarding Interagency Edison should be directed to:

Extramural Inventions and Technology Resources Branch
National Institutes of Health
6705 Rockledge Drive, MSC 7980
Bethesda, Maryland 20892-7980
Telephone: (301) 435-1986
Facsimile: (301) 480-0272
E-mail: edison@od.nih.gov

The report of the invention and a copy of the signed invention disclosure must be reported electronically through the Interagency Edison Web interface. To submit the signed disclosure electronically requires that it be rendered as a PDF or TIFF file. The signed disclosure should contain a brief description of the original invention including the Title, Inventor(s) Name(s), and source of Federal support used (e.g., Agency Award Number). After the report and disclosure are received in the iEdison system NIFA will have access to a copy of the disclosure document.

Other Invention, Patent, and Utilization Reporting Information

Electronic Submission Via Interagency Edison Web Interface: The Interagency Edison is to be used to exact any changes to the disposition of the invention, including title election or non-election, assignment of rights to third parties, patent application(s), and patents received.

As with the invention disclosure, iEdison also supports electronic submission of documents required for several other aspects of the Bayh-Dole reporting process, as detailed below.

1. Once a patent is applied for and an application serial number is available, an executed confirmatory license to the Government must be submitted. Such a license must also be submitted in instances where the invention has been licensed but not patented (as is the case of biological materials and any inventions that fall within the scope of the Plant

Variety Protection Act). For this purpose iEdison provides a confirmatory license template (<https://s-edison.info.nih.gov/iEdison/license.jsp>) that should be electronically submitted through the iEdison system.

2. Commensurate with patent application or issued patent the awardee organization must submit a copy of the portion of the patent that contains the "Government Support Clause," offering proof of formal acknowledgment of Government support of the patent's underlying invention.
3. Requests for assignment of rights to third parties (e.g., the inventor) must include certification by the inventor. The certification process is defined and can be carried out as described on NIFA's intellectual property website (<http://www.nifa.usda.gov/business/awards/intellprop.html>). The signed certification may be submitted to NIFA by U.S. mail, email (preferable) or facsimile.
4. Requests for waiver of the domestic manufacturing requirement must be submitted to the NIFA office via facsimile (preferable) or U.S. Mail, including a detailed justification.

Paper Submission Via U.S. Mail: If it is not possible to electronically submit supporting documentation using Interagency Edison, documentation should be sent directly to NIFA at the above address or e-mailed.

- b. **Title Election and Patent Submission:** Within two years of an invention disclosure, a recipient must resolve the title to the invention: to elect to retain invention rights or waive rights. Should the recipient elect title, a non-provisional patent application must be filed, or notify this agency of its intentions pursuant to [37 CFR Part 401.14\(c\)\(2\)](#) and (3). If the recipient fails to either 1) notify the Government of its intentions or 2) exercise its option to file for a patent within the specified time periods, then the Government may exercise its right of ownership pursuant to [37 CFR Part 401.14\(d\)\(1\)](#) and (2).
- c. The Government shall not be entitled to publicly disclose or publish research results except under any one of the following circumstances:
 - 1) The award recipient publicly discloses or gives permission for publication; or
 - 2) The award recipient does not elect to file for a U.S. patent on such results, pursuant to [37 CFR Part 401.14\(c\)\(2\)](#) and (3); or
 - 3) After the award recipient files for a U.S. patent pursuant to [37 CFR Part 401.14\(c\)\(3\)](#). "Publications" include publicly accessible databases such as Genbank; and "research results" include genome maps and sequences.
- d. Copyrights - See [7 CFR Part 3019.36](#).